



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/431,533	11/03/89	MURTON	D 1818462

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18M1/0313

EXAMINER

DAVIS, M

ART UNIT

PAPER NUMBER

1806 54

DATE MAILED:

03/13/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 12/15/96 page 1

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 19, 62-79 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 19, 62-79 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

BEST AVAILABLE COPY

Art Unit: 1806

This is a supplemental action to the action mailed on 01/15/97. This action is to respond to the declaration by Ralph A. Reisfeld, under 37 CFR 1.132, which was mailed on December 18, 1996 and was not received by the examiner at the time of the action on 01/15/97. The period of response has been restarted to reflect the mail date of the instant Office action. Claims 19, 62-65, and 66-79 are being examined.

The text of those sections of Title 35, US Code not included in this action can be found in a prior Office action.

REJECTION UNDER 35 USC 102/103

Rejection under 35 USC 102(b)/103 of claims 19, 62, 65, 67-68, 71, 73-79, pertaining to anticipation by Euhus, R. et al., 1988, remains for reasons already of record in paper No.52, and for reasons as follows:

Applicant argues that the reference does not provide any information on the amino acid sequence of U-TAA; thus a meaningful description of this molecule is not provided by the abstract. Furthermore, although the murine antibody that binds U-TAA is mentioned by Euhus et al., this antibody is neither described, nor was it publicly available at the time the instant application was filed. Moreover, the method by which the murine antibody was produced is not described.

Applicant's arguments set forth in the declaration in paper No. 53 have been considered but are not deemed to be persuasive for the following reasons:

Art Unit:

Rejection of claims 19, 62, 65, 67-68, 71, 73-79 remains. Although Euhus et al. do not teach the amino acid sequence of U-TAA, the information concerning U-TAA provided by Euhus et al. is not different than that of the claims 19, 62, 65, 67-68, 71, 73-79 in this instant application. That is the claims 19, 62, 65, 67-68, 71, 73-79 of this instant application do not disclose any amino acid sequence of U-TAA.

The description of the antibody that binds to U-TAA and its public availability are not relevant to the examination of this instant application because the claims 19, 62, 65, 67-68, 71, 73-79 in this instant application are drawn to an antigen U-TAA, and not to its antibody. The properties of the claimed anti-U-TAA antibody, e.g. binding to a specific region of U-TAA, are not the properties of U-TAA which are the criteria for distinguishing U-TAA taught by Euhus et al., and the claimed U-TAA.

All other rejections under 35 USC 112, first paragraph, 102 and 102/103 remain for reasons already of record in paper No.52.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh-Tam B. Davis whose telephone number is (703) 305-2008. The examiner can normally be reached on Monday-Friday from 7:00am to 3:30pm.

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Art Unit:

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee, can be reached on (703) 308-2731. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0916.

Minh-Tam B. Davis

March 5, 1997



**LILA FEISEE
SUPERVISORY PATENT EXAMINER
GROUP 1800**